

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Kay-Yut Chen	§ Art Unit:	3623
Serial No.:	09/944,969	§ Confirmation No.:	2217
Filed:	August 30, 2001	§ Examiner:	David Robertson
For:	Method and Apparatus for Modeling Business Processes	§ Atty. Dkt. No.:	10004567-1 (HPC.0328US)

Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

The following sets forth Appellant's Reply to the Examiner's Answer dated August 26, 2009.

In response to the Examiner's Answer, in which new grounds of rejection were identified, Appellant respectfully requests that the appeal be maintained. The new grounds of rejection are addressed in the Reply Brief below.

STATUS OF CLAIMS

Claims 1-23 are pending.

GROUNDS OF REJECTIONS TO BE REVIEWED ON APPEAL

Claims 1-9, 18-21, and 23 were rejected under 35 U.S.C. § 101 based on Supreme Court precedent, and recent Federal Circuit decisions.

Claims 10-17 and 22 were rejected under 35 U.S.C. § 101 because the claimed invention encompasses non-statutory subject matter.

Claims 10-17 and 22 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Chaturvedi et al., “Synthetic Economies: The Application of Distributed Interactive Computing Environments for Policy and Management Decision Making,” Institute for Defense Analyses (Chaturvedi/IDA) with Mehta, “Simulations in Economics and Management,” Communication of the ACM (Chaturvedi/ACM), and further in view of U.S. Patent No. 6,405,173 (Honarvar), P.R. Sugges, “The Use of Computerized Business Games to Simulate Business Behavior Under Different Policies,” IEEE 1979 Winter Simulation Conference (Sugges),” and U. Fischbacher, “z-Tree – Zurich Toolbox for Readymade Economic Experiments – Experimenter’s Manual,” Institute for Empirical Research in Economics (Fischbacher).

ARGUMENT

A. SECTION 101 REJECTION OF CLAIMS 1-9, 18-21, AND 23

The Examiner argued that independent method claims 1 and 18 do not recite statutory subject matter since these claims do not transform subject matter or are not tied to a machine or apparatus. 08/26/2009 Examiner's Answer at 4.

Appellant respectfully disagrees. It is noted that the "providing" element of claim 1 recites providing player definitions defining a plurality of **players** and an associated set of rules. As explained by the specification, the "players" can be humans or computers. Thus, the player definitions of claim 1 represent physical objects, such as humans or computers. It is noted that claim 1 further recites that the player definitions are **translated** into at least one codified script. The translating of the player definitions (which represent physical objects, such as humans or computers) into at least one codified script involves a **transformation** that satisfies the requirements of *In re Bilski*. See *In re Bilski*, 545 F.3d 943, 956 (Fed. Cir. 2008) (*en banc*). As held by *In re Bilski*, a "claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus or (2) it transforms a particular article into a different state or thing." *Id.* at 954.

As further specifically held by *In re Bilski*, a claim is not required to involve any transformation of the underlying physical object that data represents to satisfy the machine-or-transformation test. *Id.* at 963. As stated by *In re Bilski*, the transformation of data into another representation of a physical object was sufficient to satisfy the transformation test.

In the present claim, the data that is transformed includes the player definitions that define players (which are physical objects such as humans or computers). These player definitions are translated (transformed) into at least one codified script, which is then executed to

produce useful results. It is thus clear that the claimed process is limited to a practical application of a principle to transform specific data that represents specific physical objects (players). *See id.* As articulated by *In re Bilski*, there is no danger here that the scope of the claim would wholly preempt all users of the principle. *Id.*

In view of the foregoing, it is clear that claim 1 recites statutory subject matter.

Independent claim 18 similarly recites statutory subject matter. Therefore, withdrawal of the § 101 rejection of the above claims is respectfully requested.

B. SECTION 101 REJECTION OF CLAIMS 10-17 AND 22

Independent claim 10 was rejected under § 101 as being directed to non-statutory subject matter based on the allegation that the apparatus of claim 10 includes solely software modules unrelated to computer-readable media. Appellant respectfully disagrees with this assessment of claim 10. Claim 10 recites an apparatus that comprises a business process definition module, a script translator module, and a simulation module. As depicted in Fig. 1 of the present specification, a script translation module 140, a simulation module 150, and a business model definition module are part of a business process modeling system. Specification, page 5, line 19. As would be understood by a person of ordinary skill in the art, such a system would have to be implemented in a computer or other hardware-based processing system. Therefore, it is respectfully submitted that the modules recited in claim 10 include hardware components (and possibly software components).

In view of the foregoing, it is respectfully submitted that claim 10 is directed to statutory subject matter.

Therefore, withdrawal of the § 101 rejection of the above claims is respectfully requested.

C. SECTION 112, ¶ 2, REJECTION OF CLAIMS 10-17 AND 22

Independent claim 10 was rejected under § 112, ¶ 2, as being indefinite based on the allegation that the apparatus claim is without structure and comprises solely software modules. As discussed above, such an allegation is incorrect. It is respectfully submitted that the modules of claim 10 would include at least hardware elements. Therefore, reversal of the § 112, ¶ 2, rejection is respectfully requested.

D. SECTION 103 REJECTION OF CLAIMS 1-23

The § 103 rejection has already been addressed in the Appeal Brief. Therefore, reversal of the § 103 rejection is respectfully requested in view of the arguments presented in the Appeal Brief.

E. CONCLUSION

In view of the foregoing, and in view of the arguments presented in the Appeal Brief, reversal of all final rejections is respectfully requested.

Respectfully submitted,

Date: October 26, 2009

/Dan C. Hu/

Dan C. Hu
Registration No. 40,025
TROP, PRUNER & HU, P.C.
1616 South Voss Road, Suite 750
Houston, TX 77057-2631
Telephone: (713) 468-8880
Facsimile: (713) 468-8883